

**REMARKS**

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112.

Claims 24 and 25 have been revised to more precisely describe various stages in the claimed process. These stages are set forth on page 14 of the specification. The isocyanate monomers used to prepare the allophanates are defined in claims 24 and 25 as linear alkyl isocyanates in accordance with the disclosure on page 15, lines 31-33 of the specification. Claims 25, 28, 40, 46 and 52 have been amended to clarify that the alcohols used in the allophanatization reaction are C<sub>4</sub>-C<sub>8</sub> linear alkyl alcohols. Claim 46 also has been amended to insert the feature of claim 51. Claims 47-51 have been canceled without prejudice or disclaimer. Claims 24-42, 44-46 and 52-58 are currently pending in this application.

Claims 24-39, 41 and 42 were rejected under 35 U.S.C. §112, second paragraph, for the reason given in paragraph (2) of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

Amended claims 24 and 25 clarify that the alcohol limitation refers to the allophate(s) added to the cyclocondensate reaction product. As such, it is believed that this rejection has been obviated and should be withdrawn.

Claims 24-42 and 44-58 stand rejected under 35 U.S.C. §112, first paragraph, for the reasons set forth in paragraph (3) of the Office Action. Reconsideration of this rejection is respectfully requested for at least the following reasons.

Applicants respectfully submit that the scope of the term “true trimer” would be readily apparent to those of ordinary skill in this art based on their review of the present disclosure and the knowledge possessed by those skilled in this art. The term “true trimer” is defined in the prior art for reasons fully discussed in previous Responses. Applicants have

considered the Examiner's comments concerning U.S. Patent Nos. 6,653,432 and 6,492,456 and respectfully disagree. U.S. Patent No. 6,653,432 defines "true trimers" as "compounds obtained by condensation of three molecules of initial isocyanate monomers comprising a single uretdione ring" (column 6, lines 40-43). U.S. Patent No. 6,492,456 defines a "true trimer" as "constituting the product of theoretical cyclocondensation of three molecules of isocyanate monomers" (column 5, lines 2-5). These definitions are not inconsistent. Those of ordinary skill in this art would appreciate the scope and meaning of "true trimer" as that term is used herein. The term has a recognized meaning in the art.

For at least the above reasons, the §112, first paragraph rejection should be withdrawn. Such action is respectfully requested.

Claims 24-42 and 44-58 were rejected under 35 U.S.C. §112, second paragraph, for the reasons given in the paragraph (2) on page 3 of the Office Action. Reconsideration and withdrawal of this rejection are requested for at least the following reasons.

The legal standard for determining compliance with the second paragraph of 35 U.S.C. §112 is whether the claims reasonably apprise those of ordinary skill in the art of their scope. See *In re Warmerdam*, 33F.3d 1354, 1361, 31 U.S.P.Q.2d 1754, 1759 (Fed. Cir. 1994). In determining whether this standard is met, the definiteness of the language employed in the claim should be analyzed, not in a vacuum, but in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *In re Johnson*, 558 F.2d 1008, 1015, 194 U.S.P.Q. 187, 193 U.S.P.Q. 187, 193 (CCPA 1977).

Applicants have considered the Examiner's remarks regarding the term "derived isocyanate function. The objected to terminology is defined in the specification (page 6, lines 20-22; page 8, lines 3-6). Applicants disagree with the Examiner's position that the

terminology is repugnant to the art recognized definition. It is Applicants' position that the scope of the quoted terminology would be clearly recognized by those of ordinary skill.

Concerning claim 45, Applicants respectfully disagree with the Examiner's position. The process set forth in claims 40 and 45 is fully exemplified in working Examples 4-6. Applicants submit that the scope of claim 45 would readily be apparent to those of ordinary skill without specifying amounts of each product obtained in each step.

In view of the above, the rejection based on 35 U.S.C. §112, second paragraph, should be reconsidered and withdrawn.

Claims 46-50, 53 and 54 were rejected under 35 U.S.C. §102(b) as anticipated by EP 649866 for the reasons given in paragraph (5) of the Office Action. Reconsideration of this rejection is respectfully requested in view of the above amendments and the following remarks.

Claim 51 was not rejected on this ground. The feature of claim 51 has now been added to claim 46. Claims 47-51 have been canceled. Accordingly, the §102(b) rejection has been obviated and should be withdrawn.

Claims 24-42, 44, 45, 51 and 52 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,235,018 to Potter et al. or U.S. Patent No. 5,248,482 to Jacobs et al. or EP 649 866 for the reasons expressed in paragraphs 7-12 of the Office Action. Reconsideration of these rejections is requested in view of the above amendments and for at least the following reasons.

All pending claims now specify (1) that the tricondensates and allophanates are separately prepared and then mixed together, (2) that the allophanates are prepared by reacting linear alkyl isocyanates with C<sub>4</sub>-C<sub>8</sub> linear alkyl alcohols, and (3) the resultant tricondensate polyfunctional composition contains less than 2% of tricondensate allophanate

and unexpectedly possesses a low viscosity. Neither Potter et al. '018 nor Jacobs et al. '482 nor EP '866 discloses or suggests methods or compositions which include all these features.

The Office Action acknowledges the fact that none of these cited documents disclose admixing separately prepared reaction products but contends that a decrease in viscosity of a component would be expected when a less viscous material is added thereto. Respectfully, Applicants disagree and note the phenomenon of gelation where admixing of materials of lower viscosity actually leads to formulations of higher viscosity. Thus, one cannot reasonably predict the results of admixing components of different viscosities.

The comments set forth in paragraphs (9)-(12) are considered moot in view of the present amendments which specify C<sub>4</sub>-C<sub>8</sub> linear alkyl alcohols, low viscosity compositions, and the use of linear alkyl isocyanates in preparing the allophanates which exclude the cycloaliphatic isocyanate monomers used in Potter et al. '018 and Jacobs et al. '482.

For at least the above reasons, the §102(b) and §103(a) rejections over Potter et al. '018, or Jacobs et al. '482, or EP '866 should be withdrawn. Such action is earnestly requested.

Claims 24-26, 28-39 and 46-58 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 4,837,359 to Woynar et al. for reasons set forth in paragraphs (13) and (14) of the Office Action. Reconsideration and withdrawal of this rejection are requested for at least the reasons which follow.

Woynar et al. '359 does not disclose the use of linear C<sub>4</sub>-C<sub>8</sub> alkyl alcohols to prepare a mono-allophanate and obtain low viscosity polyisocyanate compositions. In response to the comment in paragraph (14), the process claims now specify that low viscosity compositions are obtained by separately preparing and admixing the respective reaction products, and that the compositions contain less than 2% of tricondensate allophanate.

Accordingly, this reference fails to render obvious the presently amended claims. The §103(a) rejection based on Woynar et al. '359 is inapplicable and should be withdrawn.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is respectfully requested. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.

Respectfully submitted,

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from Burns, Doane, Swecker & Mathis)

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